

**REMARKS**

Applicant has carefully studied the Final Office Action of February 25, 2005 and offers the following remarks to accompany the above amendments.

Claims 1, 2, 15, 16, and 19 are amended to clarify antecedent basis for claim elements and to make the preambles consistent. No new matter is added.

Applicant turns initially to the Response to Arguments section beginning on page 7 of the Office Action. In that section, the Patent Office asserts that no affidavit signed by Alan F. Graves was submitted. Applicant respectfully traverses this assertion. Applicant submitted the affidavit as evidenced by the attached copy of the receipt listing an "Affidavit from Applicant" stamped on December 1, 2004. The stamped receipt constitutes *prima facie* evidence that the Patent Office received the affidavit of Mr. Graves on the date stamped. So that the file is complete, Applicant submits herewith a copy of the signed affidavit and the supporting exhibits. This affidavit satisfies the requirements of 37 C.F.R. § 1.131 to establish proof of conception along with diligence until a constructive reduction to practice via the filing of the patent application. This affidavit effectively removes Turner et al. from the pool of available prior art as explained in the previous response, and the rejections based thereon are improper.

Since the Patent Office made the Office Action of February 25, 2005 Final in part due to the loss of the affidavit of Mr. Graves, Applicant requests withdrawal of the finality, consideration of the affidavit, and withdrawal of the rejections of the claims rejected in view of Turner.

Applicant now turns to the other rejections. Claims 1, 15, 16, 19-22, and 58 were rejected under 35 U.S.C. § 103 as being unpatentable over Applicant's Prior Art Figure 1 (hereinafter referred to as "APA") in view of Kosaka et al. (hereinafter "Kosaka"). Applicant respectfully traverses.

Applicant previously argued that there was no motivation to combine the references and that the Patent Office had relied on impermissible hindsight reconstruction to combine the references. The Patent Office responds by stating that hindsight reasoning is acceptable so long as it only takes into account only knowledge which was within the level of ordinary skill at the time the invention was made. While this statement may be true in the abstract, the Federal Circuit has imposed some guidelines on the Patent Office to help insure that the Patent Office is not relying on Applicant's disclosure to create a rejection. Specifically, when proposing a

combination of references, the Patent Office must do two things. First, the Patent Office must articulate a motivation to combine the references, and second, the Patent Office must support the articulated motivation with actual evidence. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999) (emphasis added).

In the present case, the Patent Office asserts that the motivation to combine the APA and Kosaka is "to equalize the power in each of the plurality of narrowband optical signal." Applicant respectfully traverses. The Patent Office has not provided any evidence to support this asserted motivation as required by the Federal Circuit. As such, the motivation is improper. Applicant further notes that there is no teaching or suggestion that Kosaka can be used to equalize the various signals passing through Kosaka's optical gain adjusters 17. That is, Kosaka does not perform any adjustments to the signal at one wavelength ( $\lambda_1$ ), and there is no indication that the other two signals are modified so that they are equal to the first signal. To this extent, Kosaka does not solve the issues raised by the articulated motivation. The fact that Kosaka does not resolve the issue raised by the articulated motivation is further evidence that the combination is non-obvious.

Thus, since the Patent Office has not articulated a motivation that compels the combination, the combination is improper. Even if the motivation did compel the combination (a point which Applicant does not concede), the Patent Office has not properly supported the motivation, and the combination is improper. Since the combination is improper for two independent reasons, the rejection is improper. Since the rejection is improper, the Patent Office has not established *prima facie* obviousness. Since the Patent Office has not established obviousness, the claims are allowable.

Claims 2, 3, 23, and 24 were rejected under 35 U.S.C. § 103 as being unpatentable over APA in view of Kosaka, and further in view of Taylor et al. (hereinafter "Taylor"). Applicant respectfully traverses. The standard for combining references is set forth above.

Applicant initially traverses the rejection because the underlying combination of APA and Kosaka is improper as explained above. The Patent Office does not cure the deficiencies of this underlying combination in this rejection. Since APA and Kosaka are not properly combinable, the rejection is improper, and the claims are allowable.

Applicant further traverses the rejection because the motivation to combine Taylor with APA and Kosaka is independently improper. The Patent Office asserts that the motivation is

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"since power monitoring is well known in the art for adjusting or controlling the signal intensity so that the received powers are substantially equal." This asserted motivation lacks the actual evidence required by the Federal Circuit. Since the motivation lacks the requisite actual evidence, the motivation is improper. Since the motivation is improper, the combination is improper. Since the combination is improper, the rejection is improper, and the claims are allowable.

Applicant further traverses the motivation to the extent that the motivation does not compel the combination. While the Patent Office asserts that the motivation is to have the received powers substantially equal, there is no indication that the power monitoring of Taylor actually makes the received powers substantially equal. Rather, the asserted motivation appears to come from Applicant's disclosure. Thus, since the motivation does not compel the combination, the combination is improper. Since the combination is improper, the rejection is improper, and the claims are allowable for this reason as well.

Applicant requests reconsideration of the rejections in light of the remarks presented herein. The Patent Office cited references which have been demonstrated to be unavailable as prior art. Likewise, the Patent Office has improperly combined the references in constructing the rejections. Since the rejections are improper, the claims are allowable. Applicant earnestly solicits claim allowance at the Examiner's earliest convenience.

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<u>4/25/05</u> Date of Transmission

Respectfully submitted,

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